

ELECTRONICALLY FILED ON: July 12, 2006

Attorney Docket No. 28690.705.302

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application)	
)	Confirmation No.: 1644
Inventors: Thomas BRENNAN et al.)	
)	Art Unit: 1637
Application No.: 10/602,998)	
)	Examiner: Christopher M. Babic
Filed: June 23, 2003)	
)	
Title: Method and apparatus for performing large)	Customer No. 021971
numbers of reactions using array assembly)	

REQUEST FOR RECONSIDERATION OF PETITION
TO GROUP DIRECTOR UNDER 37 C.F.R. § 1.181

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants hereby request reconsideration of the Petition Decision rendered by the Group Director of TC 1600, George Elliott on June 20, 2006, denying the petition for entry of the amendment after final rejection, filed April 24, 2006.

The claimed invention concerns a solid support that comprises primers for performing polynucleotide amplification reactions. In response to a non-final Office Action, Applicants amended the claims to specify that the primers that are comprised in Applicant's solid support are releasable before, during or after an amplification reaction. In response to that amendment, the Examiner issued a final Office Action rejecting the claims over Monteforte and asserting that the reference teaches "primers can be released after amplification."

Pursuant to an interview with the Examiner, Applicants' attorney filed an amendment after final narrowing the scope of the claims by limiting to the release of the primers before amplification and requesting cancellation of the terms "during or after."

The Examiner denied entry of the Amendment After Final asserting that the amendment raised new issues requiring further search and did not place the case in better form for appeal by materially reducing or simplifying issues for appeal. The Examiner stated that the amendment changed the scope of the claims and would require further search and consideration.

Applicants' petitioned the denial of entry of the after final amendment asserting that **first** the Examiner in effect suggested the amendment in the interview, **second** that a complete search of the previous claim to before, during or after would have included references drawn to each embodiment and **third** the amendment does reduce the issues for appeal.

The petition for entry was denied as not persuasive because:

1. Remarks made by the Examiner in the interview were not an invitation to amend the claims guaranteeing entry thereof.
2. Applicants' claims set forth the alternatives of before, during or after and there was no requirement that the Examiner find every adaptation during his search.
3. The issues for appeal are not reduced as a new search and consideration is necessary as the proposed amendment deletes "during or after" which significantly changes the scope of the claims.

Applicants request reconsideration of the decision and the conclusions based on arguments to issues 2 and 3.

It is true that the claim recited three alternatives and prior art showing only one of those alternatives is sufficient for a rejection of the claim. However, faced with the claim to A, B or C

before the final rejection, the Examiner was obligated to search for each of the embodiments recited in the claim. See MPEP 904.02, which states "The search should cover the claimed subject matter and should also cover the disclosed features which might reasonably be expected to be claimed." Here, "before, during and after" were claimed and each feature should have been searched before the final rejection was entered. This is emphasized in MPEP 707.07 (a) and (g) which require the Examiner to do a complete first office action treating all aspects and to avoid piecemeal examination. Presented with three alternatives, the Examiner is obligated to provide a complete search and examination of the whole scope of the claim. Although it is possible for the Examiner to use prior art to only one embodiment to reject the claim, it is not acceptable to only search one of the embodiments. Rejecting only one embodiment is a risk since the examination was always supposed to cover the entire scope of the claim. Similarly, in the case of A, B or C, if the amendment were made cancelling B or C after first action, requiring the Examiner to cite new art, such action could not properly be made final since A was always present in the claim and could have been rejected in the first Office action.

The Petition Decision asserts that the issues for appeal are not reduced as a new search and consideration is necessary since the deletion significantly changes the scope of the claims. The scope of the claims is narrowed by the deletion and the rejection obviated. A new search should not be required at this point because the claim was treated on the merits and the Examiner was obligated to search and examine the entire scope of the claim presented for examination before the final rejection. Applicants are entitled to consideration of the entire claim and the MPEP advises Examiners of the requirement to do a complete office action treating all aspects of the invention. Therefore, no additional search should be required at this time as the limitation that would be left in the claim (before amplification) was present before the final rejection and based on the record was

treated on the merits and examined. Clearly, this cannot now be deemed to represent a new issue or requiring further search.

In conclusion, the Petition should be granted for entry of the Amendment After Final Rejection as it simplifies the issues and places the application in condition for allowance or better condition for appeal. Applicants respectfully request that the denial of the Petition for entry be reconsidered and granted.

The Director is authorized to charge any fees that may be required in connection with this submission, including petition fees and extension of time fees, and to credit any overpayments to Deposit Account No. 23-2415 (attorney Docket No. 28690-705.302).

Respectfully submitted,

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